

Order Issued
on Submitted Matter

FILED
JAN 23 2013

DAVID H. YAMASAKI
Chief Executive Officer/Clerk
Superior Court of CA County of Santa Clara
BY WANDA WALDERA DEPUTY

**SUPERIOR COURT OF CALIFORNIA
COUNTY OF SANTA CLARA**

CARLA ISON, PH.D.,

Plaintiff,

vs.

GOOGLE, INC., a California corporation;
YAHOO! Inc., a California corporation, and
DOES 1 through 98, inclusive,

Defendants.

Case No. 1-10-CV-163032

ORDER RE: MOTIONS FOR SUMMARY
JUDGMENT (2)

The two separate Motions for Summary Judgment/Adjudication by Defendant Yahoo! Inc. ("Yahoo") and Defendant Google, Inc. ("Google") directed at all remaining causes of action in Plaintiff's Fourth Amended Complaint ("4AC") came on for hearing before the Honorable Kevin E. McKenney on January 8, 2013, at 9:00 a.m. in Department 20. The matter having been submitted, the Court finds and orders as follows:

Plaintiff's request for a continuance to allow for discovery into both Defendants' alleged misuse of Plaintiff's "Ison Marks" is DENIED. The declaration of Plaintiff's limited scope

1 counsel Saralynn Mandel does not satisfy the requirements for a mandatory continuance under
2 CCP §437c(h) in that it fails to establish why the information sought is essential to opposing
3 these motions (both of which primarily argue that the “Ison Marks” do not qualify for
4 trademark/trade name protection) and fails to give any estimate of the time necessary to obtain
5 such evidence. The request is therefore a discretionary request. Framed as such, the request is
6 DENIED because it does not seek discovery relevant to the central thrust of both motions; that
7 the “Ison Marks” are descriptive terms which must be shown to have acquired secondary
8 meaning before they are even entitled to protection as trademarks and/or trade names. See *FSR*
9 *Brokerage, Inc. v. Sup. Ct.* (1995) 35 Cal App 4th 69, 73-74 (no error in denying continuance to
10 investigate moving party’s knowledge of certain conditions where summary judgment motion
11 was based on other grounds); *Depew v. Crocodile Enterprises, Inc.* (1998) 63 Cal App 4th 480,
12 493 (no error in denying request for discovery of corroborative evidence that was not “essential”
13 to justify opposition); *Ace American Ins. Co. v. Walker* (2004) 121 Cal App 4th 1017, 1023 (court
14 need not grant a continuance where the proposed discovery is “focused on matters beyond the
15 scope of the dispositive issues framed by the pleadings.”)

19 Defendants’ separate motions for summary judgment are both GRANTED as follows:
20 Plaintiff is bound by her pleading on summary judgment. See *Nieto v. Blue Shield of Calif. Life*
21 *& Health Ins.* (2010) 181 Cal App 4th 60, 73 (“the pleadings determine the scope of relevant
22 issues on a summary judgment motion.”) Despite Plaintiff’s arguments to the contrary in her
23 oppositions and at the hearing on these motions, Defendants have established that all causes of
24 action remaining in Plaintiff’s 4AC depend on the assertion that the “Ison Marks” are protected
25 trademarks/trade names. See 4AC at 12: “This lawsuit relates to the use of trade names on the
26 Internet, particularly the unauthorized use of the trade names [hereafter the ‘CARLA ISON
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1 Marks'] that identify CARLA ISON, doing business as Carla Ison, Ph.D., or
2 www.carlaisonphd.com to Internet users. The fundamental purpose of trade name law in the
3 bricks-and-mortar world and on the Internet is to protect consumers from being confused as to
4 the source or affiliation of the products or services that they seek to buy.” At 14-15 the 4AC
5 continues to allege that: “Google and Yahoo are identified in this lawsuit because the problem of
6 misuse of the Ison Marks has occurred on the websites and through the technology of each of
7 these Defendants . . . The reason for the misuse of the Plaintiff’s trademark by Defendants
8 Google and Yahoo is clear: the Defendants profit by directly infringing trademarks, by selling
9 rights to the use of trademarks to third parties, and by forcing trade or service mark owners to bid
10 on their own marks in order to have their company or professional information placed at or near
11 the top of a search result list when someone does a search on their trademarks on the Defendants’
12 websites.”

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15 Not only does the 4AC incorporate these allegations into every cause of action by
16 reference, but as Defendant Yahoo points out (in its brief at 7:22-26) each of Plaintiff’s
17 remaining causes of action also contains language making it clear that all of them arise from and
18 depend upon Plaintiff’s allegations that the “Ison Marks” are protected trademarks/trade names.
19 See 4AC at 84-100 (1st cause of action, “Common Law Trade Name/Service Mark
20 Infringement”), 104-110 (2nd cause of action, “Contributory Trade Name/Service Mark
21 Infringement”), 123-129 (4th cause of action, “Dilution [of trademark] under the Common
22 Law”), 132-134 (5th cause of action, “Misappropriation”) and 146-147 (7th cause of action,
23 “Unfair Competition,” alleging in part that Defendants “have been unjustly enriched through
24 their unlawful and unauthorized sales and other uses of the Carla Ison Marks . . .”)
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1 “A trademark may be protected under the common law or the Lanham Act if it is either
2 inherently distinctive or it has acquired distinctiveness. Inherently distinctive trademarks—such
3 as fanciful, arbitrary, or suggestive words and symbols—are protected ‘because their intrinsic
4 nature serves to identify a particular source of a product [or service].’ But *trademarks that are*
5 *not inherently distinctive—such as descriptive words or symbols—are protected only if they have*
6 *acquired secondary meaning*, i.e., they ‘h[ave] become distinctive of the [owners’] goods [or
7 services] in commerce.’ *Generally, ‘personal names are regarded as in the same category as*
8 *descriptive terms’ and ‘are placed by the common law into that category of noninherently*
9 *distinctive terms which require proof of secondary meaning for protection.’ . . . A trademarks’*
10 primary meaning does not have to disappear for the mark to acquire secondary meaning. But the
11 mark’s primary (i.e., descriptive) meaning must be subordinate to its secondary meaning as an
12 indicator of the source of goods or services. The United States Supreme Court has explained that
13 secondary meaning ‘occurs when, ‘in the minds of the public, the primary significance of a
14 [mark] is to identify the source of the product rather than the product itself.’” *Franklin Mint Co.*
15 *v. Manatt, Phelps & Phillips LLP, et al.* (2010) 184 Cal App 4th 313, 336-338, emphasis added,
16 internal citations omitted but quoting *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.* (2000) 529
17 U.S. 205, 211.

18 Both of Plaintiff’s “Ison Marks” are descriptive terms and under both California and
19 federal law Plaintiff has the burden of proving that they have acquired secondary meaning before
20 they are protected as trademarks and/or trade names. The allegations of the 4AC itself,
21 Plaintiff’s discovery responses and deposition testimony (attached as exhibits to the declarations
22 of Yahoo counsel Christopher Varas and Google counsel Michael Powell) and the market survey
23 and declaration by Hal Poret (presented by Yahoo but also relied on by Google) are sufficient to
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1 establish: 1) that all of Plaintiff's remaining claims are based on and depend upon the allegation
2 that her "Ison Marks" are protected trademarks/trade names; 2) that Plaintiff has no evidence that
3 either of her "Ison Marks," which are both plainly descriptive terms, have acquired any
4 secondary meaning, and; 3) admissible evidence—the survey by Mr. Poret of the most relevant
5 market area—establishes that the "Ison Marks" have not acquired secondary meaning in the
6 minds of the public in that most relevant market area. See *North Carolina Dairy Foundation,*
7 *Inc. v. Foremost-McKesson, Inc.* (1979) 92 Cal App 2d 98, 109-110 ("Proof of secondary
8 meaning is sufficient if it is shown that a substantial segment of the buying population associates
9 the mark with a single source. . . . Such buyers' association [or lack thereof] may be shown by a
10 scientifically conducted opinion survey in the relevant market area. . . . The admissibility and
11 weight of such evidence [are] matters committed to the sound discretion of the trial court.")

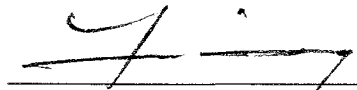
12 Bracketed comments added. This evidence meets both Defendants' initial burdens.

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15 When the burden shifts to Plaintiff, she is unable to raise any triable issues of material
16 fact through admissible evidence. "There is a triable issue of material fact if, and only if, the
17 evidence would allow a reasonable finder of fact to find the underlying fact in favor of the party
18 opposing the motion in accordance with the applicable standard of proof." *Aguilar v. Atlantic*
19 *Richfield Co.* (2001) 25 Cal.4th 826, 850. Plaintiff is bound by the allegations in her Complaint,
20 her statements in discovery and in deposition testimony all to the effect that she believes her
21 "Ison Marks" are protected trademarks/trade names and have been so protected since she began
22 using them regardless of her lack of market penetration. Plaintiff has no evidence that her marks
23 have acquired secondary meaning and the unsworn statement by Robert Duboff submitted by
24 Plaintiff does not qualify as an affidavit. See CCP §2003 ("Affidavit Defined"), "An affidavit
25 is a *written declaration under oath*, made without notice to the adverse party." Emphasis added.
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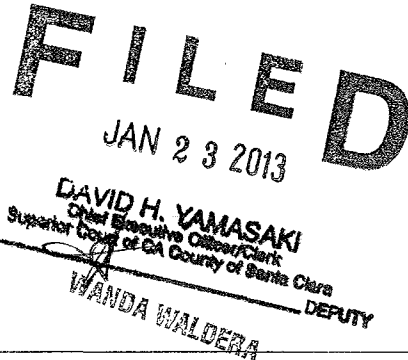
1 Even if the contents of the Duboff statement were considered, because the statement does
2 nothing more than criticize the Poret report Plaintiff still is without any evidence to satisfy her
3 burden of establishing that her allegedly protected marks have acquired secondary meaning.
4 Given the evidence submitted, no reasonable finder of fact could find for Plaintiff on the key
5 question of whether her "Ison Marks" have acquired secondary meaning in the minds of the
6 public sufficient to qualify as protected trademarks and/or trade names.
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10 Dated:

January 22, 2013

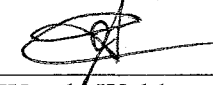


Kevin E. McKenney
Judge of the Superior Court

SUPERIOR COURT OF CALIFORNIA COUNTY OF SANTA CLARA		
Plaintiff: CARLA ISON, PH.D.		
Defendant: GOOGLE, INC, etc., et al		
PROOF OF SERVICE BY MAIL OF: ORDER RE: MOTIONS FOR SUMMARY JUDGMENT (2); ORDER ON MOTION FOR LEAVE TO FILE FIFTH AMENDED COMPLAINT; and, ORDER DENYING CONTINUANCE OF TRIAL		Case Number: 1-10-CV-163032

CLERK'S CERTIFICATE OF SERVICE: I certify that I am not a party to this case and that a true copy of this document was mailed first class, postage fully prepaid, in a sealed envelope addressed as shown below and the document was mailed at SAN JOSE, CALIFORNIA on January 23, 2013:

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